

## REMARKS

### **Disposition of the Claims**

Claims 23-49 are pending. Independent claim 23 is amended to remove superfluous language. No new matter is added.

New claim 51 derives from the specification as filed at paragraph [0049].

New claim 52 derives from the specification as filed at paragraph [0064].

### **Section 103 Rejections**

A. Claims 23-50 stand rejected under 35 U.S.C. § 103(a) as obvious over *Bailey et al.* (US 6,368,545) in view of *Agouri*. The Applicants traverse this rejection, as one skilled in the art would not look to *Agouri* and thus a *prima facie* case has not been made.

The Examiner stated that “*Agouri et al.* teach a film having 60-90 wt.% low density polyethylene and 40-10 wt.% high density polyethylene (column 2, lines 16-20) for the purpose of obtaining a film having superior properties to a film comprising high density polyethylene alone (column 5, lines 60-64).”<sup>1</sup> However, the Examiner is taking this statement out of context. At column 5, lines 60-64, what *Agouri* teaches is that “LDPE must be mixed with HDPE or PP prior to the grafting of the styrene monomer if it is desired to obtain . . . sheaths having [desirable] properties.” (emphasis added). *Agouri* is directed to styrene-containing polymers for use in sheaths and in fact states that, without such functionality, polyethylene (LDPE or LLDPE) alone is insufficient.

As stated in Applicant’s last response, *Agouri* would not be looked to by one skilled in the art because it is not teaching the use of LDPE (or LLDPE) in making films, but in fact teaching away from using low-density polyethylene.

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<sup>1</sup> Office Action, page 2.

- **Problem being solved in Agouri:** It is known that LDPE is not adapted for use in producing films for sheaths because it is too soft and does not exhibit rustling property. (Col. 1, lines 35-41).
- **Solution in Agouri:** Prepare a film made from styrene-grafted LDPE. (Col. 1, lines 62-66).
- **Applicant's Traversal:** One skilled in the art would not be motivated to combine the teaching in *Agouri* (styrene-grafted LDPE) with *Bailey* to arrive at a three-layer film of claims 23 and 24 (comprising LLDPE and styrene-free mPE, respectively);
  - *Agouri* teaches away from using styrene-free polyethylenes ("rustling" characteristic, see col. 5, lines 31-36, Table III); and
  - Changing the LDPE of *Bailey* to the styrene-modified polyethylene of *Agouri* would render the invention in *Bailey* unsatisfactory for its intended use in, for example, bread bags (*Agouri* seeks polyethylenes with the "rustling" characteristic, see col. 5, lines 31-36, Table III, specific for certain types of packaging).
  - Point of Law: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 II.V. (8<sup>th</sup> ed, Rev. 7).
  - Point of Law: "It is improper to combine references where the references teach away from their combination." MPEP § 2145 X.D.2.

The Federal Circuit in *Takeda Chemical v. Alphapharm PTY*, 492 F.3d 1350 (Fed. Cir 2007) held that a reference that teaches away from a claimed invention, especially in chemical cases, renders the invention non-obvious in light of the reference. In that case, a compound similar to that being claimed was disclosed in the prior art, but also found to have detrimental

(unfavorable) aspects. Thus, the court found this to be a teaching away and the patentee's invention was non-obvious. The court stated that "We do not accept Alphapharma's assertion that *KSR* . . . mandates reversal. Relying on *KSR*, Alphapharma argues that the claimed compounds would have been obvious because the prior art compound fell within 'the objective reach of the claim,' and . . . obvious to try." *Id.* at 1359. The court then stated they did not agree with Alphapharma's argument, stating that "the closest prior art compound . . . exhibited negative properties that would have directed one of ordinary skill in the art away from that compound." *Id.* (emphasis added). Such is the case here. The styrene-modified polyethylenes of *Agouri* are directed to a different purpose than those of *Bailey* and those being claimed, and combining the teaching of *Agouri* with either would be contrary to the purpose of *Agouri*, *Bailey* and the current invention.

Applicants thus request the withdrawal of this rejection.

**B.** Claims 24-50 stand rejected under 35 U.S.C. § 103(a) as obvious over *Bailey et al.* (US 6,368,545) in view of *Agouri* and further in view of *Lind et al.* (US 2001/0003624). Applicants traverse this rejection for the same reasons as above in (A).

Applicants thus request the withdrawal of this rejection.

**C.** Applicants add new claims 51 and 52. With respect to the new claims 51 and 52, the Applicant contends that these claims are allowable as they are not disclosed in any of *Bailey*, *Agouri* or *Lind*. It is common to use such additives in bags to reduce the coefficient of friction, among other things. And it is known that films made from metallocene polyethylenes can have increased coefficient of friction. Thus, it is surprising to have films without such additives.

If there are any suggestions or questions regarding this amendment, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application. If necessary, this paper should be considered as a petition for an Extension of Time

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sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1712 (Docket #2003B101A-US).

Respectfully submitted,

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/Kevin M. Faulkner/  
Kevin M. Faulkner  
Attorney for Applicants  
Registration No. 45,427

Post Office Address (to which correspondence is to be sent):

**ExxonMobil Chemical Company**  
*Law Technology*  
P.O. Box 2149  
Baytown, Texas 77522-2149  
Telephone No. (281) 834-5933  
Facsimile No. (281) 834-2495